

1 BOIES, SCHILLER & FLEXNER LLP
2 Stuart Singer (*pro hac vice*)
3 ssinger@bsfllp.com
4 401 East Las Olas Blvd, Suite 1200
Fort Lauderdale, FL 33301
Tel: 954-356-0011
Fax: 954-356-0022

5 David L. Zifkin (SBN 232845)
6 dzifkin@bsfllp.com
7 401 Wilshire Blvd., Suite 850
8 Santa Monica, CA 90401
Ph. 310-752-2400
Fx. 310-752-2490

9 [Additional Counsel Listed On Signature Page]

10 Attorneys for Plaintiff Academy of Motion Picture Arts and Sciences

11 UNITED STATES DISTRICT COURT
12 CENTRAL DISTRICT OF CALIFORNIA
13 WESTERN DIVISION
14

15 ACADEMY OF MOTION PICTURE
16 ARTS AND SCIENCES, a California
nonprofit corporation,

17 Plaintiff,

18 v.
19

20 GODADDY.COM, INC., et al.,

21 Defendants.
22
23
24

Case No.: CV- 13-8458 ABC (CWx)

**REPLY IN SUPPORT OF
MOTION TO CONSOLIDATE
CASE NO. CV-10-03738-ABC
WITH CASE NO. CV-13-08458-
ABC**

Date: April, 7, 2014

Time: 10:00 a.m.

Place: Courtroom 680

Complaint Filed: May 18, 2010

Trial Date: December 2, 2014

1 Plaintiff Academy of Motion Picture Arts and Sciences (“AMPAS” or
 2 “Plaintiff”) respectfully submits this Reply in Support of its Motion to Consolidate
 3 *Academy of Motion Picture Arts and Sciences v. GoDaddy.com, Inc., et al.*, Case
 4 No. CV-10-03738-ABC (“AMPAS I”) with *Academy of Motion Picture Arts and*
 5 *Sciences v. GoDaddy.com, Inc., et al.*, Case No. CV-13-08458-ABC (“AMPAS II”).

6 **Preliminary Statement**

7 GoDaddy concedes that *AMPAS I* and *AMPAS II* have many common issues
 8 of law and fact. Nonetheless, it asserts that consolidation is inappropriate for four
 9 reasons, each of which is meritless.

10 *First*, GoDaddy argues that the motion to consolidate seeks to circumvent the
 11 Court’s order keeping the domain names in *AMPAS II* out of *AMPAS I*. That
 12 argument is wrong, and is contrary to the position that GoDaddy took at the June
 13 24, 2013 status conference where it “understood” that a separate action regarding
 14 additional domain names likely would be consolidated with *AMPAS I*.

15 *Second*, GoDaddy argues that the causes of action in *AMPAS II* violate the
 16 rule against claim splitting, which prohibits bringing the *same* cause of action in
 17 separate cases. The causes of action in *AMPAS II* are *distinct* from those in *AMPAS*
 18 *I*, however, because each infringing domain names gives rise to a separate and
 19 distinct cause of action. Moreover, GoDaddy’s argument is in direct conflict with
 20 the position it took at the June 24, 2013 status conference where it said it agreed
 21 that the additional domain names should be part of a separate action.

22 *Third*, GoDaddy argues that it is entitled to broad, time consuming discovery
 23 in *AMPAS II*, but not does not identify what, if any, discovery it actually requires.
 24 In fact, very little (if any) discovery is needed (and should be allowed) in *AMPAS II*
 25 because (i) no discovery should be permitted concerning issues addressed by or
 26 resolved in the Court’s summary judgment order in *AMPAS I*; (ii) as a result,
 27 discovery in *AMPAS II* should be limited to issues uniquely related to the domain
 28 names in *AMPAS II*; and (iii) such discovery can be completed by July 2014 and

1 within the Court's schedule for *AMPAS I*.

2 *Fourth*, GoDaddy argues that consolidation will lengthen the trial and lead to
3 confusion, but provides no support for these assertions. In fact, consolidation will
4 result in a substantial reduction in the total length of the trial of *AMPAS I* and
5 *AMPAS II* because the many common issues of fact and law will be litigated in a
6 single trial.

7 Argument

8 **A. GoDaddy's Argument That Plaintiff Has Sought To Circumvent The** 9 **Court's Order Regarding Domain Names Is Meritless.**

10 GoDaddy argues that the motion to consolidate is an attempt to circumvent
11 the Court's order keeping the domain names in *AMPAS II* out of *AMPAS I*. That is
12 false. This motion to consolidate simply demonstrates why GoDaddy should not
13 have opposed adding these domain names to *AMPAS I*, because – as Plaintiff
14 explained to GoDaddy at the status conference on June 24, 2013 – the result would
15 be filing a new case that relates to *AMPAS I* and would be consolidated with it.
16 Declaration of David Zifkin ("Zifkin Decl."), Ex. 1, June 24, 2013 Hearing Tr. at
17 6:2-7:5. In particular, Plaintiff's counsel stated the following at that hearing:

18 Of the 115 names where we moved for Summary Judgment, asking the
19 Court to make as a matter of law a determination of confusing
20 similarity, 72 of them are included in the September 14th , 2011,
21 disclosure or earlier disclosures. 43 of them occurred after that date.
22 So for the 72, they would be clearly on the list, which would indicate
23 that they are now ready for ruling. And with respect to the others and
24 for whatever additional names arise after September, 2011, we would
25 first seek to resolve this case by settlement, and only if that is not
26 possible, then looking at filing an additional case, which may be stayed
27 or which may be consolidated. We, certainly, don't want to delay this
28 trial any further, but we aren't prepared to have those names just go by

1 the wayside. So we would file something if the case couldn't be
2 resolved that presumably would be transferred to this division and
3 could be held pending the result of the case or consolidated in
4 whatever way makes the most sense.

5 *Id.* at 6:9-7:2.

6 GoDaddy's counsel then agreed that the domain names disclosed after
7 September 14, 2011 should be filed in an additional case: "I'll start by saying we
8 agree that the untimely disclosed domain names should be part of a separate action
9 and shouldn't be part of this lawsuit. So we would agree with the Academy on that
10 point." *Id.* at 8:10-13.

11 After that statement from GoDaddy's counsel, the Court then advised that the
12 additional action – i.e., *AMPAS II* – would be assigned to this Court under the local
13 rules and would likely be consolidated with *AMPAS I*: "But, of course, it is true I
14 will get the case under the local rules and presuming – as I'm sure I can safely
15 presume that this case is not going to trial, it will be consolidated." *Id.* at 8:15-18.
16 Thereafter, GoDaddy's counsel responded that he "Understood" that fact at the
17 time. *Id.* at 8:19. Thus, Plaintiff's motion to consolidate is consistent with the
18 Court's prior rulings in *AMPAS I*.

19 **B. GoDaddy's "Claim Splitting" Argument Is Meritless Because Each**
20 **Infringing Domain Name Gives Rise To A Separate Cause Of Action.**

21 GoDaddy also argues that AMPAS's causes of action in *AMPAS II* violate
22 the rule against claim splitting. GoDaddy's argument is not only incorrect, but also
23 fails to apply the test to determine whether claim splitting has occurred.

24 The rule against claim splitting precludes a party from bringing the *same*
25 *cause of action* in separate litigations. *Adams v. California Dept. of Health*
26 *Services*, 487 F.3d 684, 689 (9th Cir. 2007) ("in assessing whether the second
27 action is duplicative of the first, we examine whether the causes of action and relief
28

sought . . . are the same”).¹ In this case, there can be no doubt that *AMPAS II* articulates *distinct* causes of action from *AMPAS I* because each infringing domain name gives rise to a separate and distinct cause of action under the Anticybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d), and California’s Unfair Competition Law, Cal. Bus. & Prof. Code § 17200, *et seq.* – and GoDaddy does not argue otherwise. *See, e.g.,* 15 U.S.C.A. §1125; *Suh v. Yang*, 987 F. Supp. 783, 796 (N.D. Cal. 1997) (“each allegedly infringing display of Defendant’s service name on products, advertisements, etc., could create a separate cause of action for unfair competition and trademark infringement”); *accord Klein Electronics, Inc. v. Boxwave Corp.*, 2011 WL 2560238, at *3 (S.D. Cal. June 27, 2011).²

Moreover, GoDaddy’s argument about claim splitting is at odds with the position it took at the June 24, 2013 status conference where GoDaddy agreed the domain names in *AMPAS II* should be part of a separate action from *AMPAS I* that likely would be consolidated with *AMPAS I* at a later date. *See* Section A *supra*; Zifkin Decl., Ex. 1, June 24, 2013 Hearing Tr. at 8:10-19.

C. Consolidation Will Promote The Efficient Resolution Of Both *AMPAS I* And *AMPAS II*.

GoDaddy contends that consolidation will result in delay and inefficiency

¹ The case upon which GoDaddy principally relies articulates the same test. *In re Dual-Deck Video Cassette Recorder Antitrust Litig. v. Matsushita Elec. Indus. Co. Ltd.*, 1991 WL 425379, at *3 (D. Az. Jan. 7, 1991) (“plaintiff is barred from bringing any claims in Go-Video II that are part of the *same cause of action* as that of Go-Video I”) (emphasis added).

² That the Court did not permit Plaintiff to assert these causes of action in *AMPAS I* does not bar Plaintiff from bringing them in *AMPAS II*, because, as explained herein, the causes of action in *AMPAS II* are not part of the same causes of action asserted in *AMPAS I*. *See In re Dual-Deck Video Cassette Recorder Antitrust Litig.*, 1991 WL 425379, at *4 (“The court agrees that under *Petromanagement*, plaintiff’s attempt to bring the CEP claims in Go-Video I would not estop plaintiff from arguing now that the CEP claims are not part of the same cause of action as in Go-Video I.”) (citing *Petromanagement Corp. v. Acme-Thomas Joint Venture*, 835 F.2d 1329, 1334-35 (10th Cir. 1988)). It also does not preclude consolidation of the actions. *See id.*; *Petromanagement*, 835 F.2d at 1334-35.

1 because (i) discovery in *AMPAS II* cannot be completed by July 2014, and (ii)
 2 consolidation will lengthen the trial and result in confusion. GoDaddy provides no
 3 support for either of these meritless assertions.

4 **1. Little (If Any) Discovery Is Needed in *AMPAS II*.**

5 Although GoDaddy concedes that *AMPAS I* and *AMPAS II* have many
 6 common questions of law and fact, it presumes that it is entitled to conduct broad,
 7 time consuming discovery in *AMPAS II* as if *AMPAS I* does not exist. That is
 8 incorrect, disregards the Court’s broad discretion to manage discovery, and ignores
 9 the fundamental benefit that consolidation provides by eliminating duplicative and
 10 time consuming discovery and procedures. *See Arnold v. Eastern Air Lines, Inc.*,
 11 681 F.2d 186, 193 (4th Cir. 1982) (consolidation serves to avoids unnecessary
 12 consumption of the Court’s time, unnecessary burden on parties and witnesses, and
 13 the duplication of evidence and procedures posed by multiple lawsuits); Wright &
 14 Miller, 9A Fed. Prac. & Proc. Civ. § 2383 (3d ed.).

15 Tellingly, GoDaddy’s opposition does not explain what, if any, additional
 16 discovery is actually needed in *AMPAS II*. That is because very little (if any) is
 17 needed. As explained in Plaintiff’s opening brief and left unrebutted by GoDaddy’s
 18 opposition, no discovery is needed (or should be permitted) as to issues resolved or
 19 addressed by the Court’s summary judgment order in *AMPAS I*, including for
 20 example: (i) whether the Academy’s marks are distinctive; (ii) whether GoDaddy is
 21 entitled to 15 U.S.C. § 1114(2)(D)(iii)’s “safe harbor”; (iii) whether GoDaddy’s
 22 conduct constitutes “using” and “trafficking in” domain names; and (iv) whether the
 23 ACPA’s “dilutive” prong does not require actual dilution. *See AMPAS I*, Dkt. 491.
 24 *AMPAS II* simply is not a forum for GoDaddy to re-litigate these or any other issues
 25 already decided in *AMPAS I*. Indeed, the remaining key issues on the ACPA claim
 26 in *AMPAS I* are (i) bad faith – on which Plaintiff will file a motion for summary
 27 judgment because of the undisputed intent to commercialize the domain names at
 28 issue via GoDaddy’s Parked Pages; (ii) statutory damages; and (iii) attorneys’ fees.

1 That means the only discovery that might be needed (if any) in *AMPAS II* is
 2 discovery uniquely related to the particular domain names in *AMPAS II*. *See, e.g.,*
 3 *BD ex rel. Jean Doe v. DeBuono*, 193 F.R.D. 117, 142 (S.D.N.Y. 2000)
 4 (consolidating cases and finding that discovery in the second case should be limited
 5 only to that needed to supplement discovery taken in the first case); *Tidwell v.*
 6 *Homeland Carriers, Inc.*, 2010 WL 1294135, at *1 (M.D. Ala. Mar. 30, 2010)
 7 (same).³ GoDaddy's opposition does not identify any other discovery that might be
 8 needed in *AMPAS II*. That limited discovery (if needed at all) clearly can be
 9 completed by July 2014, and therefore would not cause any delay in *AMPAS I*.⁴

10 **2. Consolidation Will Not Lengthen the Trial Or Create** 11 **Confusion.**

12 GoDaddy does not dispute that *AMPAS I* and *AMPAS II* involve the same
 13 trademarks, statutes, damages calculations, witnesses, and parties. Nonetheless, it
 14 argues that consolidation would "lengthen the trial" and "increase the likelihood" of
 15 confusion. That is incorrect.

16 First, GoDaddy argues that the trial would necessarily be lengthened because
 17 of the need to introduce additional evidence of the domain names identified in
 18 *AMPAS II*. On the contrary, a consolidated action would greatly limit the total trial
 19 time of *AMPAS I* and *AMPAS II* by eliminating the need for duplicate testimony
 20 and evidence regarding the many common issues of law and fact in the two actions.
 21 Second, GoDaddy argues that consolidation would result in confusion because the

22
 23 ³ *See also, e.g., Internet Law Library, Inc. v. Southridge Capital Management, LLC*,
 24 208 F.R.D. 59, 62 (S.D.N.Y. 2002) (finding that because discovery in one action
 25 had progressed further than another should not prevent consolidation but might
 26 "even favor it."); *Fields v. Provident Life & Accident Insurance Co.*, 2001 WL
 818353, at *6 (E.D. Pa. July 10, 2001) (consolidation was warranted when one
 action was ready for trial and the other was in its infancy because discovery and
 trial preparation in the second litigation would "overlap significantly with the work
 already completed" for the first litigation).

27 ⁴ GoDaddy asserts that it is unable to commence discovery in *AMPAS II* prior to
 28 April 7, 2014, the current date for the Rule 26 Scheduling Conference. That is
 incorrect. Under Rule 26(d), GoDaddy could have commenced discovery after the
 parties conferred as required by Rule 26(f), which occurred on March 17, 2014.

1 Court might conclude that some evidence and testimony in *AMPAS II* may not be
 2 considered in *AMPAS I*. GoDaddy provides no support for this hypothetical or why
 3 it might come to fruition. That is because it is pure speculation, and highly unlikely
 4 to occur.

5 Third, GoDaddy argues that consolidation would result in confusion because
 6 it would “lead to an extremely complicated and lengthy jury verdict form.” Yet
 7 again, GoDaddy provides no explanation as to why this would be the case. In fact,
 8 the issues that remain for trial will be non-jury, non-common law issues.⁵ *See, e.g.,*
 9 *Petroliaam Nasional Berhad v. GoDaddy.com, Inc.*, 737 F.3d 546, 550, 552-53 (9th
 10 Cir. 2013) (finding that the ACPA did not codify common law trademark
 11 infringement, but instead created a new statutory cause of action against
 12 cybersquatting), Even if that were not the case, the jury verdict form would not be
 13 complicated by consolidation because of the many of common issues of law and
 14 fact in *AMPAS I* and *AMPAS II*.⁶

15 **D. The Consolidated Action Should Follow *AMPAS I*’s Schedule.**

16 In its opposition, GoDaddy requests – if the Court is inclined to consolidate
 17 the actions – “(1) a continuance of all existing deadlines in *AMPAS I* for a period of
 18 no less than six months to accommodate the fact and expert discovery to be
 19 completed in *AMPAS II*, and (2) that the issuance of a consolidation order be
 20 delayed until such time as the parties are able to complete all fact discovery related
 21

22 ⁵ Plaintiff intends to move for summary judgment on the remaining issues in
 23 *AMPAS I*, including GoDaddy’s bad faith intent to profit under the ACPA because
 24 of its undisputed intent to commercialize the domain names via its Parked Pages
 Program.

25 ⁶ GoDaddy’s reliance on *Applied Materials, Inc. v. Advanced Semiconductor*
 26 *Materials America, Inc.*, 1994 WL 16780779 (N.D. Cal. April 19, 1994), is
 27 misplaced. In *Applied Materials*, the factual and legal overlap between the two
 28 cases was de minimis, and consolidation “would require the jury to understand
 three separate technologies” and “would require the same jury to deal with four
 patents” when “a patent case involving a single patent is difficult enough for a jury
 because patent cases are notoriously complex.” *Id.* at *2. *AMPAS I* and *AMPAS II*
 present none of those problems or complexities; indeed, both cases involve the
 same trademarks and will not present any issue for a jury to decide.

1 to *AMPAS II*, including third party discovery.” Both requests should be denied.
 2 Indeed, GoDaddy’s requests appear designed to defeat the very purpose of
 3 consolidation, which is to increase efficiency and avoid duplicative and time
 4 consuming discovery, among other things.

5 As explained above, little (if any) additional discovery is needed in *AMPAS*
 6 *II* – only discovery uniquely related to the particular domain names in *AMPAS II*.
 7 That discovery can and should be completed by July 2014. As a result, the
 8 consolidated action should be governed by the schedule in *AMPAS I*.

9 Conclusion

10 For the foregoing reasons, Plaintiff respectfully requests that the Court issue
 11 an order consolidating *AMPAS I* and *AMPAS II*, limiting discovery to issues that
 12 relate uniquely to the new domain names at issue in *AMPAS II*, precluding further
 13 discovery and motion practice related to issues addressed in *AMPAS I*, and
 14 establishing the schedule in *AMPAS I* as the schedule for the consolidated action.

15 Respectfully submitted,

16 DATED: March 24, 2014

BOIES, SCHILLER & FLEXNER LLP

FOOTE, MIELKE, CHAVEZ, & O’NEIL LLC

LEE, TRAN, LIANG, & WANG APLC

20 By: /s/David L. Zifkin

21 BOIES, SCHILLER & FLEXNER LLP

Stuart Singer (*pro hac vice*)

ssinger@bsflp.com

401 East Las Olas Blvd, Suite 1200

Fort Lauderdale, FL 33301

Tel: 954-356-0011

Fax: 954-356-0022

25 David L. Zifkin (SBN 232845)

dzifkin@bsflp.com

401 Wilshire Blvd., Suite 850

Santa Monica, CA 90401

Ph. 310-752-2400

Fx. 310-752-2490

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FOOTE, MIELKE, CHAVEZ, & O'NEIL LLC
Robert M. Foote (*pro hac vice*)
rmf@fmcolaw.com
Matthew Herman (*pro hac vice*)
mjh@fmcolaw.com
10 West State Street, Suite 200
Geneva, Illinois 60134
Tel: 630-232-7450
Fax: 630-232-7452

LEE, TRAN, LIANG, & WANG APLC
James M. Lee (SBN 192301)
jml@ltlcounsel.com
Enoch H. Liang (SBN 212324)
ehl@ltlcounsel.com
601 South Figueroa Street, Suite 4025
Los Angeles, CA 90017
Tel: 213-612-8900
Fax: 213-612-3773

Attorneys for Plaintiff Academy of Motion
Picture Arts and Sciences